

**REMARKS**

Claims 8-10, 12-14 and 16 are currently pending in connection with the present application, with claims 11, 15, 17 and 18 being cancelled without prejudice or disclaimer of the subject matter contained therein. Claims 8 and 14 are independent claims. By this Amendment, claims 8 and 14 have been amended. Applicant respectfully traverses the rejections set forth in the Office Action dated July 28, 2005.

Support for the amendment to claim 8 are found in claim 10, former claim 11, paragraph 18, and Fig. 1 of the application, for example. Paragraph 18 discloses one non-limiting example of the wheels being mounted on both frames. Fig. 1 illustrates one non-limiting example of the carrying framework moving in the peripheral direction of the annual combustion chamber. Support for the amendments to claim 14 are found in former claim 15 and Fig. 3, for example. Fig. 3 illustrates one non-limiting example of the C-shaped rail having a plurality of curved telescopic segments.

**Entry of Amendment After Final Requested – No New Issues Raised**

Claims 8 and 14 have been amended. Applicant submits that none of the claim amendments include new matter or new issues for consideration. Claim 8 has been amended to include the subject matter of claims 10 and 11. Claim 14 has been amended to include the subject matter of claim 15. Further, at the least, the Amendment should be entered since it reduces a number of substantive and/or formal issues to place the application in better form for appeal.

**PROIR ART REJECTIONS**

**35 U.S.C. §103 Dailey Rejection**

Claims 8 and 9 stand rejected under 35 U.S.C. §103 as being unpatentable over Dailey (U.S. Patent No. 5,164,826). Applicant respectfully traverses this rejection.

Applicant submits that this rejection is moot in light of the amendments to independent claim 8, incorporating the subject matter from dependent claims 10 and 11 into independent claim 8.

However, Applicant still respectfully submits that there is **no motivation for or suggestion** provided by the Examiner, besides the cursory statement that “it is another area that is not accessible to humans”. This is not any **evidence** of motivation. Applicant notes that even when obviousness is based on a single prior art reference, there must be a **showing of suggestion or motivation to modify the teachings of that reference**. See B.F. Goodrich Co v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). Here, there is none.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

**35 U.S.C. §103 Dailey/Tolino Rejection**

Claim 10 stands rejected under 35 U.S.C. §103 as being unpatentable over Dailey in view of Tolino (U.S. Patent No. 4,654,702). Applicant respectfully traverses this rejection.

The Examiner admits that Dailey fails to teach or suggest at least “four wheels are mounted on the lower frame and the upper frame” as claimed in claim 10. Applicant submits

that claim 10 is patentable because claim 10 depends on claim 8, which is patentable for the reasons set forth below.

With respect to amended independent claim 8, Applicant submits that neither Dailey nor Tolino teaches or suggests at least the features of the “carrying framework including a **lower and upper frame** ..., a plurality of wheels being mounted **on both frames...**”. While Dailey does arguably teach a robotic carriage device 33, Dailey does not teach that the **housing 35 has an upper frame and a lower frame**, wherein a plurality of wheels are mounted **on both frames**. Even, assuming *arguendo*, that the magnetic body 35 includes an upper frame and a lower frame, it is evident from the figures that **only one of the frames has wheels**. Therefore, the robotic carriage device 33 must rest upon the inner wall of the turbine by means of just one frame. Therefore, Dailey does not teach or suggest all of the features of amended, independent claim 8.

Applicant submits that Tolino fails to make up for the previously mentioned feature of claim 8 (even assuming *arguendo* that it could be combined with Dailey, which is not admitted). Further, Tolino also does not teach or suggest wheels for moving the carrying framework “in the peripheral direction of the annular combustion chamber” as recited in amended, independent claim 8.

Fig. 1 of Tolino clearly shows that the pipe crawling device can only move straight. Figs. 6 and 7 shows that the arm 121 can pivot, but the position of the wheels in reference to the arm remains unchanged. The wheels are arranged so that their axes are substantially parallel to the direction of the pipe (Col. 4, Lns. 27-33). It is evident that the crawling device vehicle is designed only to move linearly through pipe work.

Further, there is no teaching, suggestion, or motivation to modify the Tolino device to

include a driving mechanism capable of turning the wheels to maneuver in peripheral directions. Therefore, neither Dailey nor Tolino, either alone or in combination (even assuming *arguendo* that they could be combined), teach or suggest at least “a plurality of wheels **being mounted on both frames**” and/or “moving the carrying framework **in the peripheral direction of the annular combustion** chamber along the inner internal wall and outer internal wall” as recited in amended, independent claim 8.

Furthermore, Applicant submits that the alleged combination of Tolino and Dailey (even assuming *arguendo* that they could be combined) does not teach or suggest at least “a transitional rail ..., wherein the **video camera and lighting arrangement are mounted on the transitional rail so as to be movable in transitional motion**” as recited in amended, independent claim 8. This is evident from the fact that Tolino introduces a mirror into the camera’s viewable range in order to view things outside the camera’s field of view. Alternatively Tolino suggests using a second rearview camera (Col. 7, Lns. 22-35). However, Tolino does not teach or suggest the features of amended, independent claim 8 as mentioned above, taken alone or in combination with Dailey (even assuming *arguendo* that they could be combined).

Accordingly, Applicant submits that amended, independent claim 8 is patentable. Furthermore, claims 9, 10, 12 and 13 are patentable because they depend on patentable independent claim 8.

Therefore, Applicant respectfully requests that the outstanding rejections be withdrawn.

**35 U.S.C. §103 Dailey/Qureshi Rejection**

Claims 11-18 stand rejected under 35 U.S.C. §103 as being unpatentable over Dailey in view of Qureshi (U.S. Patent No. 5,956,077). Applicant respectfully traverses this rejection.

The Examiner relies on Qureshi to teach the feature of “transitional rail mounted on an end face of the inspection device, wherein video camera and lighting arrangements are mounted on a transitional rail” as taught in Applicant’s claim 11. The Examiner relies on Dailey for the remaining features of amended, independent claim 8.

With respect to former claim 11, now incorporated into amended independent claim 8, Applicant submits that amended, independent claim 8 is patentable because even assuming, *arguendo*, that Dailey and/or Tolino could be combined with Qureshi (which Applicant denies for the reasons set forth below), Qureshi would still fail to compensate for at least the deficiencies discussed above with respect to the alleged Dailey/Tolino combination. Therefore, Applicant submits that neither Dailey, Tolino, nor Qureshi, either alone or in combination, teaches or suggests all of the features of amended, independent claim 8.

Further, with respect to amended independent claim 14, Applicant submits that Qureshi does not teach or suggest at least “a self-supporting **telescopically extendable** C-shaped rail **including a plurality of curved telescopic segments**...”. While Qureshi arguably teaches a “self-supported” arm (31-36, Figs. 1-6), the arm is an articulated arm, and not “telescopically extendable”. Nor does the arm of Qureshi include “a plurality of curved telescopic segments” as recited in amended, independent claim 14. Applicant therefore submits that neither Dailey nor Qureshi, either alone or in combination (even assuming

*arguendo* that they could be combined), teach or suggest the features of amended, independent claim 14.

Furthermore, there is no indication of any motivation that would lead a person of ordinary skill in art to combine the teachings of Qureshi with a telescopically extendable rail.

A person of ordinary skill in the art would immediately see that a C-shaped rail including curved telescopic segments is not capable of moving in the axial direction in a straight lined pipe. Using C-shaped rails only makes sense when annular or curvilinear housings, like annular gas turbines, are inspected and the inspection device is driven peripherally. Therefore, neither Dailey nor Qureshi, either alone or in combination, teach or suggest the feature of amended, independent claim 14.

#### ***Lack of Motivation to Combine References***

The alleged motivation cited by the Examiner for combining Dailey and Qureshi to reject the features of former claims 11-18, now the features of claims 8, 12-16, is that it would provide “more flexibility in difficult access locations”.

Applicant asserts that the Examiner’s alleged motivation is based upon Applicant’s own disclosure and is therefore an improper use of hindsight. The Examiner merely viewed the present application, and attempted to select prior art containing the missing piece (and still deficient of several limitations as indicated above), without citing specific evidence of motivation to combine the references, other than providing conclusory statements regarding the motivation and obviousness. Accordingly, absent such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicant directs the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner **must provide particular findings** as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. **Broad conclusory statements standing alone are not "evidence"**.

Neither Dailey nor Qureshi teach or suggest combining their features to arrive at former claims 11-18, now taught in claims 8, 12, 13, 14, 15 and 16; nor does the Examiner cite any particular passage to provide evidence that such a combination **would be** obvious to one of ordinary skill in the art. On the contrary, **the disclosed references** seek to **overcome differing problems** and therefore do not constitute an obvious combination.

Dailey is directed to an apparatus for inspecting steam pipes via remote control devices. Dailey employs a compact robotic carriage device carrying a video probe to reach

into steam pipes, the device being similar to a small remotely controlled vehicle, including motor drives and wheels on the lower part of the chassis. Qureshi is directed to an extended device for inserting a camera controlled arm into the interior of an elongated tank.

Qureshi does not teach or suggest using the disclosed device to inspect pipes or any other form of narrow passage.

Given the distinct and differing problems solved by the references, neither reference provides any evidence of any teaching or suggestion for their combination. Thus, it would not have been obvious to one of ordinary skill in the art to combine the teachings of Dailey and Qureshi.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002).

Further, relying on obvious design choice as a reason for combining teachings of the various references is again not the proper standard for obviousness. *If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration* setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c).

In view of the above arguments, Applicant asserts that the Examiner has not established the required motivation for combining the teachings of Dailey and Qureshi and therefore fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a).

Accordingly, Applicant submits that claims 8 and 14 are patentable. Furthermore, Applicant submits that claims 9, 10, 12, 13 and 16 are also patentable because they depend on



patentable, independent claims 8 or 14.

Therefore, Applicant requests that the rejection be withdrawn.

**CONCLUSION**

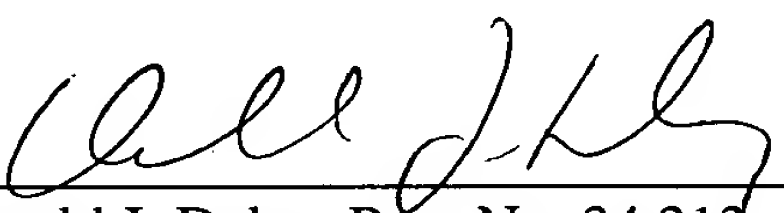
Accordingly, in view of the above amendments and remarks, reconsideration of the outstanding objections and rejections and allowance of each of claims 8-10, 12-14 and 16 of the present application is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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